

### **REMARKS**

Claims 2-5, 7-9, 16 and 17 presently are pending in the application. Claims 2-5, 7-9, 16 and 17 have been amended to define more clearly the claimed invention. It is believed and intended that no new matter has been added by this amendment. Reconsideration and allowance of all claims are requested in view of the following remarks.

#### **Miscellaneous Matters**

In the Office Action Summary, the Examiner indicates that Claims 2-5, 7-9, 16, and 17 are allowed. However, the text of the Office Action indicates that these Claims have been rejected and therefore the Applicant assumes that the Office Action Summary is in error.

The Examiner has not yet indicated acceptance of the drawings filed on March 24, 2000. The Applicant respectfully requests such acceptance.

The Applicant notes the Examiner's acknowledgement of the claim for foreign priority under 35 U.S.C. § 119 indicating that certified copies of all of the priority documents have been received.

#### **Summary of Telephone Call with Examiner**

The Examiner conducted a brief telephone conversation with the Applicant's Representative on March 15, 2004. The subject of this call was the rejection of Claims 7-9 under 35 U.S.C. § 112, and the Examiner further clarified his rejection as being based upon his reading that the kerfs alone do not affix the optical element, even in combination with the notch. The Examiner indicated that this rejection might be overcome by explicitly claiming the adhesive in Claims 7-9.

#### **Claim Rejections Under 35 U.S.C. § 112**

The Examiner rejected Claims 7-9 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states that it is not clear how the kerfs provide the recited functional limitation of "fixing the optical element", asserting that no structure has

been recited to perform the claimed function. Claims 7-9 have been amended, thus mooted the rejection of Claims 7-9 under 35 U.S.C. 112.

**Claim Rejections Under 35 U.S.C. § 103**

The Examiner rejected Claims 2-5,7-9,16, and 17 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,669,997, to Robert et al. (hereafter referenced as '997). Through inference, the Applicant understands that U.S. Patent No. 6,670,222, to Brodsky (hereafter referenced as '222) is also involved in this rejection; the Examiner is respectfully requested to provide confirmation of this understanding. This rejection is traversed for at least the following reasons.

'997 discloses a method for bonding together molecularly homogenous objects, such method involving forming micro-thin grooves in one of two surfaces to be bonded together and flowing adhesive into the grooves to form chemical bonding of the members (Abstract). Such bonding is achieved by laser-ablating a thin groove in one of the contact surfaces and wicking a low viscosity adhesive into the cavity (col. 2, lines 3-18).

'222 discloses enhancing the binding strength between surfaces that are secured together, such as by lamination process or an adhesive, by texturing with a plurality of indentations formed in at least one of the surfaces to be bonded (Abstract).

An apparatus and method consistent with the present invention relate to fixing an optical component by scoring the surface of a support, bringing the optical component into close contact with the scored surface of the support, and flowing a fluid adhesive along kerfs produced by the scoring (page 3, lines 4-8). A portion of the surface can be formed with a notch, and the scoring may then form kerfs communicating with the notch (Figs. 2-3, 5).

Neither '997, '222, nor any combination thereof suggests forming a notch in the support and scoring the surface of the support to form kerfs communicating with the notch, as presently claimed. Though the Examiner states that it would have been obvious to a person having ordinary skill in the art at the time of the invention to provide the mounting surface of '997 with a plurality of grooves having any pattern, because the texturing provided (sic) the grooves will

enhance the bonding strength, the Examiner has not provided a motivation to combine the teachings of the cited references.

While '997 is in the optical field, as is the present invention, '222 is in the field of die attachment pads and therefore does not have the same considerations of transparency and optical integrity as '997 and the present invention. For example, Fig. 8 of '222 clearly depicts the surfaces to be joined (95 and 92) as being totally separated from one another by a thick layer of thermally conductive adhesive 96. In contrast, both '997 and the present invention are concerned with bringing the joined surfaces together with as little adhesive therebetween as possible. Consequently, one of ordinary skill in the art would certainly not look to the field of die attachment pads when attempting to make the precise and optically clean joints required in the field of the present invention.

In the absence of such motivation to combine, the Examiner appears to merely be applying hindsight to the references with knowledge of the presently claimed invention, which is not permitted. '997 is a deficient reference, as set forth above, and '222 does not cure those deficiencies. Therefore, the Applicant respectfully requests that the rejection of Claims 2-5, 7-9, 16, and 17 under 35 U.S.C. 103(a) be withdrawn.

### **Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Patent Application No. 09/534,034

Atty. Docket: Q56556

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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